

### **REMARKS**

Claims 1 and 3-25 are pending in the above application. By the above amendment, claim 2 has been cancelled, and claims 18-25 have been added.

The Office Action dated October 20, 2006, has been received and carefully reviewed. Each issue raised in that Office Action is addressed below.

### **STATEMENT OF SUBSTANCE OF INTERVIEW**

A personal interview was conducted on January 19, 2007. Present at the interview were Examiner Larry Donaghue, Examiner Asghar Bilgrami, and Applicant's representative Scott Wakeman. No exhibits were shown. Claims 1, 3, 5, 6, 9, 12-21 and proposed new claims 22-24 were discussed together with the Motoyama and Hatakama references. It was agreed that the proposed amendment to claim 1 appeared to patentably distinguish claim 1 over the art of record. The examiners also agreed that claim 6 appeared to distinguish over the art of record; however, the examiners indicated that claim 6 might be rejected under 35 U.S.C. 112, first or second paragraph in a future Office Action. The requirement for a translation of the priority document was also discussed, and the examiners agreed that this requirement would be withdrawn.

### **REQUEST FOR REVIEW BY SUPERVISORY PATENT EXAMINER**

The present Office Action is the fourth Office Action to issue in the above application. As provided in MPEP 707.02, "The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them. The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution." It is respectfully requested that the examiner's supervisor become involved in the prosecution of this application as required by the MPEP so that the application can be allowed or so that issues appropriate for appeal can be developed.

PRIORITY DOCUMENT

The Office Action includes a statement that “one or more” requirements for claiming priority have not been satisfied and proceeds to quote language regarding an English translation of a non-English provisional patent application. The present application is not based on a provisional patent application, and it is not clear what is being required or the reasons for any such requirement. It is therefore respectfully requested that the examiner explain what requirement for claiming priority has not been satisfied given that the present application is not based on a provisional patent application.

During the interview, the examiners agreed that this requirement would be withdrawn, and the withdrawal of this requirement is respectfully requested.

A PROPER MOTIVATION TO MODIFY MOTOYAMA HAS NOT BEEN IDENTIFIED

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Hatakama. Each of the pending claims will be addressed individually below. However, as an initial matter, it is respectfully submitted that a proper motivation for modifying Motoyama in view of Hatakama has not been provided and that therefore a prima facie case of obviousness has not been presented. Claims 1 and 3-21 are submitted to be allowable over the art of record for at least this reason.

The alleged motivation for combining Motoyama and Hatakama in connection with claims 1, 3, 5, 12, 13, 14, 17 and 18 is stated to be “to make the service management system more versatile and robust in term of providing assistance and making it more user friendly.” Regarding robustness, nothing in the record suggests that adding a functionality to Motoyama would make Motoyama’s system more “robust.” Motoyama does not disclose any problem with robustness, and nothing in the record suggests that Hatakama could be used to make Motoyama more robust. If the examiner continues to rely on this statement of motivation for combining the references, it is respectfully requested that an explanation be provided as how Motoyama’s system will become more robust if modified as proposed.

The Office Action also alleges that the combination would make Motoyama more “versatile.” “Versatile” means having many uses, so the proposed combination would apparently

give Motoyama more uses. However, this essentially amounts to a statement that adding features to Motoyama would provide Motoyama with more features. This tautological statement does not constitute a motivation for providing Motoyama with such new features in the first place. The fact that it might be possible to make the proposed modification does not constitute a reason for doing so. MPEP 2143.01. The Office Action also indicates that the proposed modification would make Motoyama more user friendly. Motoyama does not appear to suffer from any user friendliness problems, and this statement appears to be another way of saying that the proposed modification would provide Motoyama with more features. For these reasons, it is respectfully submitted that the above statements do not constitute a proper motivation for modifying Motoyama in view of Hatakama.

In discussing the rejection of claims 6, 9, 15, 16, 20 and 21, the Office Action identifies the motivation for modifying Motoyama based on Hatakama as: "to enhance the effectiveness of the management method resulting in better service to the user of the software functions." However, Motoyama is directed to a system that provides a vendor or third party with information about a user's use of a system. Motoyama's "management method" therefore appears to be a method of providing a vendor with information. Giving new information to a user does not make the provision of information to a vendor any more effective. This would constitute a new feature. It might be possible to add this new feature to Motoyama, but it is respectfully submitted that nothing in the record provides a reason for making this modification. The fact that a modification is possible does not constitute a motivation for making the modification. MPEP 2143.01. It is therefore respectfully submitted that a motivation for modifying Motoyama has not been provided. Because all pending claims stand rejected based on a combination of these references, it is submitted that a prima facie case of obviousness has not been presented and that claims 1 and 3-25 are allowable.

If rejections based on Motoyama and a second reference are presented in a further Office Action, it is respectfully requested that the examiner make of record alleged reasons why a person of ordinary skill in the art would have found it desirable, before reading the present disclosure, to modify Motoyama to produce the claimed invention. It is respectfully submitted that general statements to the effect that the modified product would somehow be "better" or

have more features does not satisfy the requirement of identifying a motivation.

REJECTIONS UNDER 35 U.S.C. 103(a)

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Hatakama. By the above amendment, claim 2 has been cancelled, and claim 1 has been revised to recite a service management method that includes, inter alia, steps of determining a threshold number of uses, checking usage conditions of the plurality of functions to determine which functions have been used less than the threshold number of uses, and making a computer carry out notification and promotion processing to promote a user to use a function from among the functions which have been determined to have been used less than the threshold number of uses, wherein the threshold number of uses is determined based on usage conditions of at least one of the plurality of functions. As discussed during the interview, these steps are not shown or suggested by the art of record, and claim 1 is submitted to be allowable over the art of record for at least this reason.

Claims 22-24 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claims 3, 5, 12-14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Hatakama. These claims have been amended to include limitations generally similar to the limitations added to claim 1 and are submitted to be allowable for at least the reasons presented above in connection with claim 1.

Claim 4 depends from claim 3 and is submitted to be allowable for at least the same reasons as claim 3.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Hatakama. Claim 6 requires a service management method managing an application program made up of a combination of a plurality of functions by a computer, that makes the computer carry out various steps including detecting that a specific function is selected or performed and updating a management file which records usage conditions of the plurality of the functions so as to distinguish the detected function from an undetected function. Claim 6 further requires that the functions be grouped into at least a first level and a second level, at least one function in the

first level being associated with at least one function in the second level, and the at least one function in the first level is identified as used only if all functions in the second level that are associated with the at least one function are identified as used. The Office Action acknowledges that the limitations regarding the grouping of functions is not shown by Motoyama. However, the Office Action indicates that this aspect of the claimed invention is disclosed in Hatakama at column 4, lines 39-67 and at column 5, lines 24-50. Column 4, lines 39-67, of Hatakama describes a customizable help display in a computer program that may take into account a user's skill level in determining what help to offer. No grouping of functions into first and second levels as required by claim 6 is discussed. Column 5, lines 24-50, of Hatakama discusses logging the number of times certain functions are used, but does not discuss grouping functions into first and second levels or the other limitations of claim 6. Because these features of the invention are not shown or suggested by Motoyama or Hatakama, it is respectfully submitted that claim 6 is allowable over these references.

If this rejection is maintained, it is respectfully requested that the examiner identify the first function and associated second functions in Hatakama and explain how the first function is identified as used only if all functions in the second level associated with that function are identified as used to clarify the grounds for this rejection. As discussed during the interview, such a hierarchical arrangement of choices is not shown by the art of record.

Claims 7 and 8 (as well as claims 10 and 11) are discussed on page 5 of the Office Action as being rejected based on "Motoyama-Horvitz." It is not clear whether claims are still being rejected based on Horvitz, or whether the examiner intended to refer to Motoyama and Hatakama, the newly cited reference, or whether the examiner is making further reference to Motoyama alone to show where elements of these claims are believed to be present. Based on the record, it appears that the examiner is citing to portions of Motoyama. If this is incorrect, it is respectfully requested that clarification be provided in the next Office communication.

Claims 7 and 8 depend from claim 6 and are submitted to be allowable for at least the same reasons as claim 6. In addition, claim 7 recites a step of displaying data which includes at least either of data on a used function and data on an unused function described in a management file, on an activation screen of said application program. The portion of Motoyama cited in the

Office Action makes no mention of an activation screen of an application program. Claim 7 is submitted to further distinguish over the references of record for this reason.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Hatakama. Claim 9 recites functions grouped into at least a first level and a second level, at least one function in the first level being associated with at least one function in the second level, and the at least one function in the first level is identified as used only if each function in the second level that is associated with the at least one function is detected a predetermined number of times. As discussed above in connection with claim 6, these limitations are not shown or suggested by the art of record. Claim 9 is therefore submitted to be allowable for at least the reasons presented above in connection with claim 6.

Claims 10 and 11 depend from claim 9 and are submitted to be allowable for at least the same reasons as claim 9.

Claims 15, 16, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Hatakama. Each of these claims has been amended to include a limitation regarding functions being grouped in first and second levels and a function in the first level being identified as used only if each function in the second level is identified as used. These claims are therefore submitted to be allowable for at least the reasons provided above in connection with claim 6.

New claim 25 is also submitted to be allowable over the art of record. Claim 25 recites a service management method managing an application program made up of a combination of a plurality of functions by a computer, the functions being grouped into a plurality of function groups such that each function group either (a) contains at least one function group or (b) corresponds to a function, and including a function group for carrying out processing to transmit/receive information via a network. Neither Motoyama nor Hatakama shows or suggest a service management method as recited in this claim, and claim 25 is therefore also submitted to be allowable over the art of record.

## CONCLUSION

Each issue raised in the Office Action dated October 12, 2006, has been addressed, and it

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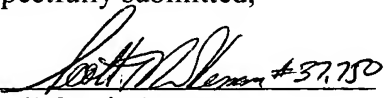
is believed that claims 1 and 3-25 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By  #37,750  
Terrell C. Birch

Registration No.: 19,382

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant